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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/683,951	Applicant(s) KIRSCH ET AL.
	Examiner TAE K. KIM	Art Unit 2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 October 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-118 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-118 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 October 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1668)
 Paper No(s)/Mail Date 01/05/04; 10/19/04; 05/09/05; 09/27/06; 01/05/07
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

This is in response to the application filed on October 9, 2003 where Claims 1 – 118, of which Claims 1 and 67 are in independent form, are presented for examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 67 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 4 of U.S. Patent No. 7,366,761 (hereinafter "Patent '761"). Although the conflicting claims are not identical, they are not patentably distinct from each other because a whitelist (a score indicating a likelihood the received e-mail message is unsolicited e-mail) is created by "compiling statistics" using identifying information about the sender from the received information as stated in Col. 19, Lines 7-15 of Patent '761. Furthermore, parts b) and c) of Claims 1 and 67 of

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the current application are identical to the limitations described in Claim 4 of Patent '761 of what the identifying information can be and where that information is sent.

Current Application	Patent 7,366,761
<u>Claim 1</u> <p>In a network, a method for categorizing received e-mail messages comprising:</p> <ul style="list-style-type: none"> a) receiving an e-mail message; b) identifying information about a sender of the e-mail message including at least one of the following: <ul style="list-style-type: none"> i) an actual sender ii) a final IP address used by the sender; iii) a final domain name used by the sender; iv) an IP path used by the sender; c) sending the information about the sender and disposition of the e-mail message to at least one database, wherein the at least one database includes one of the following: <ul style="list-style-type: none"> i) a central database; ii) at least two centrally-maintained databases, each storing and compiling different information and statistics; and iii) a local database; d) compiling statistics based on the information about the sender; and e) using compiled statistics to create a score indicating a likelihood the received e-mail message is unsolicited e-mail. 	<u>Claim 1</u> <p>A computerized method for creating a whitelist of approved senders of e-mail messages comprising:</p> <ul style="list-style-type: none"> a) adding to the whitelist any e-mail addresses stored by a user of an e-mail program; b) scanning messages the user has sent and adding to the whitelist any e-mail address in an outgoing message; and c) adding to the whitelist any e-mail address of a sender of a message having the same subject line as another message previously sent by the user; wherein the adding and scanning steps are performed by software executing program instructions. <u>Claim 4</u> <p>The method of claim 1 further comprising:</p> <ul style="list-style-type: none"> a) scanning messages received by the user; and b) determining if a sender of a received message is on the whitelist, wherein if the sender is on the whitelist: <ul style="list-style-type: none"> i) identifying information about the sender of the message based on data in the message, the identified information about the sender including at least one of the following: <ul style="list-style-type: none"> A) an actual sender of the message; B) a final IP address used by the sender; C) a final domain name used by the sender; or
<u>Claim 67</u> <p>In a network, a method for rating received e-mail messages in a network environment comprising:</p> <ul style="list-style-type: none"> a) collecting information about a sender of an e-mail message, wherein the 	

<p>information includes at least one of the following:</p> <ul style="list-style-type: none">i) an actual sender;ii) a final IP address used by the sender;iii) a final domain name used by the sender; andiv) an IP path used by the sender; <p>b) compiling statistics at at least one database about the sender based on the collected information, wherein the at least one database includes one of the following:</p> <ul style="list-style-type: none">i) a central database;ii) at least two centrally-maintained databases, each storing and compiling different information and statistics; andiii) a local database; and <p>c) creating a score based on the compiled statistics indicating the likelihood a message is unsolicited e-mail.</p>	<p>D) an IP path used by the sender; and</p> <ul style="list-style-type: none">ii) sending the identified information to at least one of the following:<ul style="list-style-type: none">A) a central database;B) at least two centrally-maintained databases; orC) a local database.
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Information Disclosure Statement

The information disclosure statement (IDS) submitted on January 5, 2004, October 19, 2004, May 9, 2005, September 27, 2006, and January 5, 2007 were filed after the mailing date of the U.S. Application on October 9, 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 27, 29 – 37, 39 – 44, 48 – 95, 101 – 118 are rejected under 35

U.S.C. 102(e) as being anticipated by U.S. Appl. 2003/0233418, invented by Phillip Y. Goldman (hereinafter "Goldman").

1. Regarding Claims 1 and 67, Goldman discloses of a method for categorizing and rating received e-mail messages in a network [Fig. 3; sorting received email]

comprising:

- a) receiving an e-mail message [Fig. 2; Para. 0034, 0038; mail processor examines and processes each incoming electronic message];
- b) identifying information about a sender of the e-mail message [Para. 0066; filter module identifies the sender's email address] including at least one of the following:
 - i) an actual sender [Para. 0039, 0045; sender's email address is determined to be authorized when it is confirmed that the message was from the actual sender];
- c) sending the information about the sender and disposition of the e-mail message to at least one database [Para. 0045; data structure used to store sender's email addresses], wherein the at least one database includes one of the following:
 - i) a central database [Fig. 4; Para. 0045; centralized email address database for "authorized," "unauthorized," or "unconfirmed"];

d) compiling statistics based on the information about the sender [Para. 0058 and 0064; response module determines if the reply message by the sender is substantially accurate]; and

e) using compiled statistics to create a score indicating a likelihood the received e-mail message is unsolicited e-mail [Para. 0049, 0058, and 0064; if the response is determined to be substantially accurate, then the sender's address is categorized as "authorized"].

2. Regarding Claims 2, 3, 68, and 69, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses that the actual sender is identified by a signature including at least two of the following fields from the message header:

a) an e-mail address used by the sender [Fig. 4; Para. 0045; sender's email address is stored];

c) a domain name used by the sender [Fig. 4; Para. 0045; sender's domain name can also be stored].

3. Regarding Claims 4 and 70, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses that the score increases as a number of accepted messages having the same information about the sender as the received message increases [Para. 0058; sender is given multiple opportunities to properly respond to the request sent by the request module and will determine the sender "authorized" if the response is timely and substantially accurate], the information including one of the following:

a) an actual sender [Para. 0046; sender's address can actually identify the sender].

4. Regarding Claims 5 and 71, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses that the score decreases as a number of rejected messages having the same information about the sender as the received message increases [Para. 0058; sender is given multiple opportunities to properly respond to the request sent by the request module and will determine the sender "unauthorized" if the response is not timely or not substantially accurate], the information including one of the following:

a) an actual sender [Para. 0046; sender's address can actually identify the sender].

5. Regarding Claims 6, 7, 72, and 73, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses that the score increases and decreases as a number of unique users in the network accepting or rejecting messages, respectively, having the same information about the sender as the received message increases or decreases, respectively [Para. 0096, 0098; the source of the categorization relates to the degree of certainty regarding whether the sender is actually sending wanted or unwanted messages and the network exchange module can apply the categorization based on multiple clients within a local network], the information including one of the following:

a) an actual sender [Para. 0046; sender's address can actually identify the sender].

6. Regarding Claims 8 and 74, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of determining the final IP address by identifying an IP address of a first network device used to send the e-mail message to a second network device trusted by a recipient of the message [Fig. 1; Para. 0033; email is routed through one or more SMTP servers before reaching the server connected to the recipient's device].

7. Regarding Claims 9 and 75, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of determining the final domain name by identifying a domain name of an IP address of a first network device used to send the e-mail message to a second network device trusted by a recipient of the message [Fig. 1; Para. 0033; email is routed through one or more SMTP servers before reaching the server connected to the recipient's device].

8. Regarding Claims 10 and 76, Goldman discloses all the limitations of Claims 8 and 75 above. Goldman further discloses of determining the final domain name used by the sender by removing a predetermined number of subdomains from the domain name of the IP address of the first network device used to send the e-mail message to the second network device trusted by the recipient of the message [Fig. 1; Para. 0033; email is routed through one or more SMTP servers before reaching the server connected to the recipient's device].

9. Regarding Claims 11, Goldman discloses all the limitations of Claims 1 above. Goldman further discloses of creating a whitelist indicating which messages will be accepted by a recipient [Fig. 4; Para. 0045; centralized email address database for

"authorized," "unauthorized," or "unconfirmed"], the accepted messages identified by at least one of the following:

a) an e-mail address [Fig. 4; Para. 0045; centralized email address database for "authorized," "unauthorized," or "unconfirmed"].

10. Regarding Claims 12, Goldman discloses all the limitations of Claims 11 above. Goldman further discloses of placing the message in the recipient's inbox if the whitelist indicates the recipient will accept the message [Para. 0051; if sender's address is already authorized, the module sends the message directly to the user's inbox].

11. Regarding Claims 13, Goldman discloses all the limitations of Claims 1 above. Goldman further discloses of creating a blacklist which indicates which messages will not be accepted by a recipient [Fig. 4; Para. 0045; centralized email address database for "authorized," "unauthorized," or "unconfirmed"], the unaccepted messages identified by at least one of the following:

a) an e-mail address [Fig. 4; Para. 0045; centralized email address database for "authorized," "unauthorized," or "unconfirmed"].

12. Regarding Claims 14, Goldman discloses all the limitations of Claims 1 above. Goldman further discloses of disposing of the message if the blacklist indicates the recipient will not accept the message [Para. 0052; sender's address is already categorized as unauthorized, the message is sent directly to a trash bin or automatically deleted], the disposal of the message including one of the following:

b) deleting the message [Para. 0052; automatically deleted].

13. Regarding Claims 15, 16, and 77, Goldman discloses all the limitations of Claims

1 and 67 above. Goldman further discloses that the information about received messages sent to the at least one database includes at least two of the following:

- a) information about the actual sender [Para. 0046; sender's address can actually identify the sender];
- b) whether the actual sender is included on a recipient's whitelist [Fig. 4; Para. 0045; centralized email address database for "authorized"].

14. Regarding Claims 17 and 78, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of requesting the at least one database to send a recipient of the e-mail message statistics about at least one of the following:

- a) an actual sender [Para. 0046; sender's address can actually identify the sender].

15. Regarding Claims 18 and 79, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of storing information about messages sent from an actual sender including at least one of the following:

- b) a number of messages sent over a first predetermined time period [Para. 0058; the sender must manually respond to the request in a timely and substantially accurate manner within a predetermined time period].

16. Regarding Claims 19 and 80, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of storing information about messages sent from a final IP address [Fig. 1; Para. 0033; email is routed through one or more SMTP servers before reaching the server connected to the recipient's device] including at least one of the following:

b) a number of messages sent over a first predetermined time period [Para. 0058; the sender must manually respond to the request in a timely and substantially accurate manner within a predetermined time period].

17. Regarding Claims 20 and 81, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of storing information about messages sent from a final domain name [Fig. 1; Para. 0033; email is routed through one or more SMTP servers before reaching the server connected to the recipient's device] including at least one of the following:

b) a number of messages sent over a first predetermined time period [Para. 0058; the sender must manually respond to the request in a timely and substantially accurate manner within a predetermined time period].

18. Regarding Claims 21 and 82, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of storing information about messages using an IP path [Fig. 1; Para. 0033; email is routed through one or more SMTP servers before reaching the server connected to the recipient's device] including at least one of the following:

b) a number of messages sent over a first predetermined time period [Para. 0058; the sender must manually respond to the request in a timely and substantially accurate manner within a predetermined time period].

19. Regarding Claims 22 and 83, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses that compiling statistics includes at least one of the following:

h) determining a difference between a first number of expected messages sent by the actual sender and a second number of unexpected messages sent by the actual sender; [Para. 0058; sender has multiple opportunities to provide an accurate, timely response to determine if the sender's address is authorized; if one accurate, timely response is submitted, the difference between the number of unexpected messages and expected messages will not be the same number of unexpected messages].

20. Regarding Claims 23 and 84, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses that compiling statistics includes at least one of the following:

h) determining a difference between a first number of expected messages sent by any sender using a final IP address and a second number of unexpected messages sent by any sender using a final IP address [Para. 0058; sender has multiple opportunities to provide an accurate, timely response to determine if the sender's address is authorized; if one accurate, timely response is submitted, the difference between the number of unexpected messages and expected messages will not be the same number of unexpected messages].

21. Regarding Claims 24 and 85, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses that compiling statistics includes at least one of the following:

h) determining a difference between a first number of expected messages sent by any sender using the final domain name and a second number of unexpected

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messages sent by any sender using the final domain name [Para. 0058; sender has multiple opportunities to provide an accurate, timely response to determine if the sender's address is authorized; if one accurate, timely response is submitted, the difference between the number of unexpected messages and expected messages will not be the same number of unexpected messages].

22. Regarding Claims 25 and 86, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses that compiling statistics includes at least one of the following:

h) determining a difference between a first number of expected messages sent by any sender using the IP path and a second number of unexpected messages sent by any sender using the IP path [Para. 0058; sender has multiple opportunities to provide an accurate, timely response to determine if the sender's address is authorized; if one accurate, timely response is submitted, the difference between the number of unexpected messages and expected messages will not be the same number of unexpected messages].

23. Regarding Claims 26 and 87, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of setting a predetermined threshold for accepting messages [Para. 0058; the sender must manually respond to the request in a timely and substantially accurate manner (predetermined threshold)] identified by one of the following:

a) the actual sender [Para. 0046; sender's address can actually identify the sender].

24. Regarding Claims 27 and 88, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of accepting messages when information about the message exceeds the predetermined threshold [Para. 0057, 0058; the sender must manually respond to the request in a timely and substantially accurate manner; the response can be the correct answer (exceeding the predetermined threshold) to a specific question].

25. Regarding Claims 29 and 90, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of revising statistics when a recipient changes a whitelist/blacklist status [Para. 0077; recipient can manually authorized sender's addresses through an interface] of one of the following:

a) an actual sender [Para. 0046; sender's address can actually identify the sender].

26. Regarding Claims 30 and 91, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of creating a key for storing information about the actual sender [Para. 0050; any desired set of folder or message boxes can be used based on the categorization of the sender via various colors, fonts, icons, etc.].

27. Regarding Claims 31 and 92, Goldman discloses all the limitations of Claims 30 and 91 above. Goldman further discloses that the key is the information used to identify the actual sender [Para. 0046; sender's address can actually identify the sender].

28. Regarding Claims 32, 41, and 93, Goldman discloses all the limitations of Claims 29 and 90 above. Goldman further discloses that a manual reversal of a whitelist/blacklist status is more heavily weighted when computing statistics [Para.

0074-0077; the recipient can manually authorize a sender's address and the filter sorts through for authorized addresses first (as shown in Fig. 8), therefore, the manual reversal is more heavily factored in the determination of whether the address is authorized].

29. Regarding Claim 33, Goldman discloses all the limitations of Claim 1 above. Goldman further discloses of processing the received message includes placing the message in the recipient's inbox [Para. 0051; authorized emails sent directly to user's inbox].

30. Regarding Claim 34, Goldman discloses all the limitations of Claim 1 above. Goldman further discloses of processing the received message includes placing the message in a spam folder [Para. 0050, 0052; filtered unauthorized messages can be sent to a trash bin or any other folder or message box].

31. Regarding Claim 35, Goldman discloses all the limitations of Claim 1 above. Goldman further discloses of monitoring the spam folder at predetermined intervals to determine whether messages should be released [Para. 0089; if the message is sent to the trash bin (spam folder), a reply message can be sent to the sender for the sender to take action to validate the address; reply messages have predetermined time for reply as disclosed previously].

32. Regarding Claim 36, Goldman discloses all the limitations of Claim 35 above. Goldman further discloses of automatically releasing the message from the spam folder when the reputation of one of the following:

a) the actual sender [Para. 0046; sender's address can actually identify the sender] passes a predetermined threshold [Para. 0057, 0058; the sender must manually respond to the request in a timely and substantially accurate manner; the response can be the correct answer (passing the predetermined threshold) to a specific question].

33. Regarding Claim 37, Goldman discloses all the limitations of Claim 34 above. Goldman further discloses of reevaluating the spam folder immediately before it is displayed to a recipient such that information about messages in the spam folder is current when viewed by the recipient [Para. 0081; the spam folder is continuously being reevaluated based on reconfirm messages sent to the sender's addresses within the databases and thus provides the user with the most current version of the spam folder].

34. Regarding Claims 39 and 94, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses sending the recipient information [Para. 0077; manual categorization of sender's address] about at least one of the following:

a) the actual sender [Para. 0046; sender's address can actually identify the sender].

35. Regarding Claim 40, Goldman discloses all the limitations of Claim 39 above. Goldman further discloses of sending the recipient information about at least one of the following:

b) the final domain name [Para. 0045; domain name from where the message is being sent from can be configured if the actual address is not configured] when there is insufficient information about the actual sender.

36. Regarding Claims 42 and 95, Goldman discloses all the limitations of Claims 1

and 67 above. Goldman further discloses of applying the score to the appropriate message in a spam folder [Para. 0089; unconfirmed messages or messages in spam folder can also go through the verification process to confirm addresses].

37. Regarding Claims 43 and 96, Goldman discloses all the limitations of Claims 26 and 87 above. Goldman further discloses of each user setting a predetermined personalized spam threshold, wherein an incoming message that exceeds the spam threshold is sent to a folder designated to hold spam messages [Para. 0052; if the address is already categorized as unauthorized, the message associated with the address is sent directly to a trash bin].

38. Regarding Claims 44 and 97, Goldman discloses all the limitations of Claims 26 and 87 above. Goldman further discloses of each user setting a predetermined personalized delete threshold, wherein an incoming message that exceeds the delete threshold is deleted [Para. 0052; if the address is already categorized as unauthorized, the message associated with the address is automatically deleted].

39. Regarding Claims 48 and 101, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of evaluating an unknown sender based on statistics of one of the following:

b) a known final domain name used by the sender [Para. 0045; entire domain names can be determined to be authorized or unauthorized].

40. Regarding Claims 49 and 102, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of evaluating an unknown sender using either a known final IP address or a known final domain name based on statistics about other

new senders using either the known final IP address or the known final domain [Para. 0045; entire domain names can be determined to be authorized or unauthorized and can be modified within the data structure based on user changes or based on the outcome of the categorization module].

41. Regarding Claims 50 and 103, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of giving an unknown final IP address or final domain name an initial good rating [Para. 0045; user can initially rate an entire domain name authorized].

42. Regarding Claims 51 and 104, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of giving an unknown final IP address or domain name an initial rating based on the length of time the network has been in operation [Para. 0085; based on whether or not the sender's address already exists in the data structure, the sender's address is evaluated to determine the time interval since the last categorization and initiates an update request if the time interval exceed a predetermined time].

43. Regarding Claims 52 and 105, Goldman discloses all the limitations of Claims 15 and 77 above. Goldman further discloses of older members of the network overwriting a new member's message ratings when the new member's ratings are inconsistent when compared to other member's ratings [Para. 0075; if there are conflicts with the newer categorizations, the system can set a protocol which adopts the oldest categorization first].

44. Regarding Claims 53 and 106, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses that a final message score is determined by one of the following:

b) a product of two scores for the message [Para. 0074, 0075; the authorization of a message can depend on whether or not both the actual address and the domain name are authorized];

wherein the scores for messages are based on statistics associated with at least two of the following:

a) an actual sender of the message [Para. 0046; sender's address can actually identify the sender];

c) a final domain name used by the sender [Para. 0045; domain name from where the message is being sent from can be configured].

45. Regarding Claims 54 and 107, Goldman discloses all the limitations of Claims 17 and 78 above. Goldman further discloses personal statistics are checked at the local database before global statistics at either the central database or the at least two centrally-maintained databases are checked [Para. 0098, 0102, 0103; local clients can have their own databases to categorize addresses, which in turn can be distributed to the server to update the centralized and shared database].

46. Regarding Claims 55 and 108, Goldman discloses all the limitations of Claims 1 and 77 above. Goldman further discloses of rating a sender by:

a) releasing small numbers a sender's messages to recipients [Para. 0053; if the address is unconfirmed, the message is sent to the unconfirmed folder of the recipient's mail processor]; and

b) monitoring the recipients' classification of these messages [Para. 0053; within this folder, the recipient can decide that the sender's address is authorized or unauthorized before the categorization module does so].

47. Regarding Claims 56 and 109, Goldman discloses all the limitations of Claims 1 and 77 above. Goldman further discloses of changing one user's rating when other members outvote the user's rating [Para. 0096; the source of the categorization can be used to determine when to overrule or change the initial categorization].

48. Regarding Claims 57 and 110, Goldman discloses all the limitations of Claims 17 and 78 above. Goldman further discloses that either the central database or the at least two centrally-maintained databases return more than one value to the recipient [Para. 0075; the sender's address is presented for entry in two or more categories].

49. Regarding Claim 58, Goldman discloses all the limitations of Claim 33 above. Goldman further discloses of monitoring the inbox at predetermined intervals to determine whether messages should remain in the inbox [Para. 0081, 0082; periodic recategorization associated with the messages in the messaging management application can then define an authorized address as an unauthorized address and move the associated message accordingly].

50. Regarding Claims 59 and 111, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses that a first score for an unknown sender

using a known final IP address or final domain name may be obtained by multiplying a second score for the final IP address or final domain name by a number less than one [Para. 0074, 0075; the domain name of a sender can have a negative score associated with it and that score will affect the unknown sender using that known final domain name].

51. Regarding Claims 60 and 112, Goldman discloses all the limitations of Claims 11 and 67 above. Goldman further discloses of creating the whitelist by adding the following to the whitelist:

- a) any e-mail addresses stored by a user of the e-mail program [Para. 0051; the recipient can manually place the address into the authorized category];
- b) any e-mail address in an outgoing message [Para. 0094; any messages in the outbox identifies addresses previous corresponded with by the recipient and categorized as authorized]; and
- c) any e-mail address of a sender of a message having the same subject line as another message previously sent by the user [Para. 0057; the sender responding to the request module accurately will be recognized as authorized].

52. Regarding Claims 61 and 113, Goldman discloses all the limitations of Claims 60 and 112 above. Goldman further discloses of combining each e-mail address added to the whitelist with at least one other piece of information from the message header including:

- b) a domain name used by the sender [Para. 0045; address includes domain name used].

53. Regarding Claims 62 and 114, Goldman discloses all the limitations of Claims 60 and 112 above. Goldman further discloses of:

- a) scanning messages received by the user [Para. 0049; incoming messages are filtered based on categorizations stored in the data structure]; and
- b) determining if a sender of a received message is on the whitelist [Para. 0052; determining if senders' address is categorized as authorized], wherein if the sender is on the whitelist:
 - i) identifying information about the sender of the message based on data in the message [Para. 0045; sender's address includes domain name used], the identified information about the sender including at least one of the following:
 - C) a final domain name used by the sender [Para. 0045; address includes domain name used]; and
 - ii) sending the identified information to the at least one database [Para. 0053; if the sender's address is not in the confirmed as authorized or unauthorized, it is placed in the unknown list to be further categorized].

54. Regarding Claims 63 and 115, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of categorizing a received message that cannot be rated locally when user activity is observed [Para. 0085; periodic recategorization will go through the central database to update the categorization of certain addresses that have been in the data structure for longer than a predetermined period of time; the predetermined time is calculated from the last categorization, which can be done manually].

55. Regarding Claims 64 and 116, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of using a second formula to compute the score for the message when the message is reevaluated, wherein the second formula differs from a first formula used to compute the previous message score [Para. 0049, 0050, 0051, 0052; depending on the user designed filter, the message is first determined if it is within the authorized data structure (first formula), then the message is further evaluated by determining if it is within the unauthorized data structure (second formula)].

56. Regarding Claims 65 and 117, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of sending recipients a notification when any sender's reputation changes [Para. 0081, 0082; when the recategorization module changes a sender's reputation, the associated messages are moved to the appropriate folders].

57. Regarding Claims 66 and 118, Goldman discloses all the limitations of Claims 65 and 117 above. Goldman further discloses of reviewing all messages received in a predetermined time period preceding receipt of the notification and updating the categorization of the message as necessary [Para. 0081, 0082; after a predetermined period of time the recategorization module checks the validity of the address stored in the data structure].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Goldman.

58. Regarding Claim 38, Goldman discloses all the limitations of Claim 34 above.

Goldman further discloses of automatically transferring the message from the spam folder to the recipient's inbox [Para. 0083]. Goldman, however, specifically discloses of manually transferring the message from the spam folder to the recipient's inbox.

Examiner takes Official Notice (see MPEP § 2144.03) that "manually transferring the message from the spam folder to the recipient's inbox" in a computer networking environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3)

states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

It would have been obvious to one skilled in the art at the time of the invention to allow a user to manually transfer a message from the spam folder to the recipient's inbox by using the selection means of the user interface and messaging system. The system in place in Goldman for the user to manually input recipient's address into the data structure will also allow the user to select and move a message from one folder to another.

The motivation to do so is to allow the recipient to view the message in the normal viewing plane prior to determining of the sender's address was properly categorized as spam. This would be helpful if the recipient has categorized an entire domain name as unauthorized which may be accidentally moving wanted messages into the spam folder.

Claims 28, 45 – 47, and 96 – 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman, in view of U.S. Appl. 2004/0139160, filed by Andrew J. Wallace et al. (hereinafter "Wallace").

59. Regarding Claim 28, Goldman discloses all the limitations of Claim 2 above. Goldman further discloses that the message are characterized by one of the following: i) an actual sender [Para. 0046; sender's address can actually identify the sender]. Goldman, however, does not specifically disclose of setting a low threshold to differentiate wanted messages from unsolicited messages, wherein the low threshold is

either: a) greater than one percent of a number of messages sent are accepted, or b) greater than one percent of a number of unique users accepting a message.

Wallace discloses an email filtering system and method where the administrator sets a low threshold to differentiate wanted messages from unsolicited messages [Para. 0009; summed spam confidence level is compared to at least one threshold], wherein the low threshold is either: a) greater than one percent of a number of messages sent are accepted [Para. 0011, 0044; if the messages are determined to be less than 40% confidence level that the message is spam, then the message is send to the user's inbox].

It would have been obvious to one skilled in the art at the time of the invention to incorporate the spam confidence level in Wallace with the data structure in Goldman. The comparison technique used in Goldman to determine if the response from an unknown address is substantially accurate uses a comparison module to filter reply emails. Utilizing various levels of thresholds to determine if the address should be considered unauthorized or not is beneficial to further distinguishing the categorization of a particular address.

The motivation to do so is that spam mail servers can also generate automated responses make it look like the address is an authorized address. The thresholds would be able to further filter out these automated responses to better distinguish "real" addresses from "fake" addresses.

60. Regarding Claims 45 and 98, Goldman discloses all the limitations of Claims 1 and 67 above. Goldman further discloses of Goldman further discloses that the

message are characterized by having the same information about the sender including one of the following: i) an actual sender [Para. 0046; sender's address can actually identify the sender]. Goldman, however, does not specifically disclose of maintaining at either the central database or the at least two centrally-maintained databases at least four of the following values: a) a number of messages which were explicitly ranked good; b) a number of messages which were implicitly ranked good; c) a number of messages whose ranking is unknown; d) a number of messages which were explicitly ranked bad; and e) a number of messages which were implicitly ranked bad.

Wallace discloses of four different threshold levels that can be defined by the administrator in an email filtering system [Para. 0044]. Each of the threshold levels would then be able to determine the messages that are: a) explicitly ranked good [Para. 0044; less than 40% threshold level send to inbox], c) a number of messages whose ranking is unknown [Para. 0044; between 40% and 70% threshold, the message is sent to the recipient's spam folder], d) a number of messages which were explicitly ranked bad [Para. 0044; greater than 99%, the message is silently deleted], and e) a number of messages which were implicitly ranked bad [Para. 0044; between 70% and 99%, a non-delivery report is sent to the sender].

It would have been obvious to one skilled in the art at the time of the invention to incorporate the spam confidence level in Wallace with the data structure in Goldman. The comparison technique used in Goldman to determine if the response from an unknown address is substantially accurate uses a comparison module to filter reply emails. Utilizing various levels of thresholds to determine if the address should be

considered unauthorized or not is beneficial to further distinguishing the categorization of a particular address.

The motivation to do so is that spam mail servers can also generate automated responses make it look like the address is an authorized address. The thresholds would be able to further filter out these automated responses to better distinguish "real" addresses from "fake" addresses.

61. Regarding Claims 46 and 99, Goldman, in view of Wallace, discloses all the limitations of Claims 45 and 98 above. Wallace further discloses that the values represent one of the following:

a) message counts [Para. 0046; client may view the messages in a table, or a list in ascending or descending order in summary of spam confidence levels].

62. Regarding Claims 47 and 100, Goldman, in view of Wallace, discloses all the limitations of Claims 46 and 99 above. Wallace further discloses that at least four of the values being returned to the recipient to allow the recipient to apply different weights to a message in order to categorize the message [Para. 0044, 0045, 0046; administrator can modify the thresholds depending on the view of the messages in a table to aid in identifying messages that may have been miscalculated].

60. Regarding Claims 96 and 97, Goldman discloses all the limitations of Claim 87 above. Goldman, however, does not specifically disclose of each user setting a predetermined personalized delete threshold, wherein an incoming message that exceeds the delete threshold is deleted or a spam threshold where the message is sent to a folder designated to hold spam.

Wallace discloses that an incoming message that exceeds the spam threshold is sent to a folder designated to hold spam messages [Para. 0044; if a message exceeds 40% spam confidence threshold, it is delivered to a "junk mail" folder]. Wallace further discloses of each user setting a predetermined personalized delete threshold, wherein an incoming message that exceeds the delete threshold is deleted [Para. 0044; if a message exceeds 99% confidence level threshold, it is dropped silently].

It would have been obvious to one skilled in the art at the time of the invention to incorporate the spam confidence level in Wallace with the data structure in Goldman. The comparison technique used in Goldman to determine if the response from an unknown address is substantially accurate uses a comparison module to filter reply emails. Utilizing various levels of thresholds to determine if the address should be considered unauthorized or not is beneficial to further distinguishing the categorization of a particular address.

The motivation to do so is that spam mail servers can also generate automated responses make it look like the address is an authorized address. The thresholds would be able to further filter out these automated responses to better distinguish "real" addresses from "fake" addresses.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 5,619,648 – method and system of filtering messages based on databases including sender information; U.S. Patent 6,023,723 - method and system of filtering messages based on sender addresses or character

strings; U.S. Patent - 6,199,102 - method and system of filtering electronic messages where the sender can respond to a challenge to verify sender address.

Examiner's Note: Examiner has cited particular figures, columns, line numbers, and/or paragraphs in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae K. Kim, whose telephone number is (571) 270-1979. The examiner can normally be reached on Monday - Friday (8:00 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess, can be reached on (571) 272-3949. The fax phone number for submitting all Official communications is (703) 872-9306. The fax phone

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number for submitting informal communications such as drafts, proposed amendments, etc., may be faxed directly to the examiner at (571) 270-2979.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Glenton B. Burgess/

Supervisory Patent Examiner, Art Unit 2153

/Tae K. Kim/